

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RIKIYA KUWAHARA, JUNKO IGARASHI and MAKOTO NAGASAWA

Appeal No. 1997-2567
Application 08/390,029

ON BRIEF

Before KIMLIN, GARRIS, and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 4, 5, 7, 9 and 10 as amended after final rejection. Claim 8, which is the only other claim remaining in the application, stands withdrawn from consideration by the examiner as being directed toward a nonelected invention.

THE INVENTION

Appellants claim an apparatus for making marble candy.

Claim 4 is illustrative and reads as follows:

4. An apparatus for manufacturing marble candy comprising:

a plurality of hoppers in which differently colored candy masses are stored, said hoppers being provided independently;

a deposit cylinder;

a plurality of syrup imbibing openings through which candy masses are imbibed from said plurality of hoppers into said cylinder, said plurality of syrup imbibing openings being provided between at least one of said hoppers and said cylinder;

a piston moving upward within said deposit cylinder to simultaneously imbibe said candy masses from said plurality of hoppers into said deposit cylinder through said plurality of syrup imbibing openings, and moving downwards to close said plurality of syrup imbibing openings;

a nozzle having at least one twisted-blade, said imbibed candies passing through said nozzle and said twisted-blade to form a marble candy when said piston moves in a downwards direction;

a check valve provided between said plurality of syrup imbibing openings and said twisted-blade, said check valve being opened when said piston moves downward and closed when said piston moves upwards in order to prevent a back flow of said imbibed candies; and

a die into which said marble candy is poured.

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THE REFERENCES

Reetz	2,479,261	Aug. 16,
1949		
Warren et al. (Warren)	3,048,128	Aug. 7, 1962
Hahn et al. (Hahn)	4,483,669	Nov. 20,
1984		
Storck (FR '536) ¹	2,167,536	Aug. 24, 1973
(French patent application)		

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 4 and 9 over FR '536 in view of Reetz and Warren, and claims 5, 7 and 10 over FR '536 in view of Reetz and Hahn.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with the examiner that the invention recited in claims 4 and 9 would have been obvious to one of ordinary skill in the art at the time of appellants' invention over the applied references. Accordingly, we affirm the rejection of these claims.

¹Our consideration of this reference is based upon the English translation thereof which is of record.

However, we agree with appellants that the rejection of claims 5, 7 and 10 is not well founded. We therefore reverse the rejection of claims 5, 7 and 10.

Rejection of claims 4 and 9

Appellants state that claims 4 and 9 stand or fall together (brief, page 6). We therefore address only one of these claims, i.e., claim 4. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7)(1995).

FR '536 discloses an apparatus which can mix differently colored candy masses (pages 3 and 4), comprising a plurality of independent hoppers (I, II and III, figure 1) in which differently colored candy masses can be stored, a deposit cylinder (2, called a pouring valve (page 4)), a plurality of syrup imbibing openings (3) between the hoppers and the deposit cylinder (figure 1), a piston which can move upward within the deposit cylinder to simultaneously imbibe candy masses from the plurality of hoppers and move downward to close the plurality of syrup imbibing openings (page 4), and a die (9) into which the candy is poured.

FR '536 does not disclose a nozzle having at least one twisted blade. Appellants, however, do not challenge the examiner's argument (answer, page 4) that it would have been obvious to one of ordinary skill in the art to include in the FR '536 apparatus the twisted blades of Reetz (col. 2, lines 46-48; figure 1) for production of a marbleized product.

Appellants argue that it would not have been obvious to one of ordinary skill in the art to include Warren's check valve (col. 2, lines 43-46; figure 1) in the apparatus obtained by combining FR '536 and Reetz (brief, pages 12-15; reply brief, pages 3-5). Appellants do not explain, however, and it is not apparent, how the FR '536 pouring valves (2) (i.e., cylinders containing a piston; figure 1) can create the vacuum needed to suck the candy masses into the pouring valves (page 4) if the outlet of the pouring valves is open to the atmosphere. Although a check valve is not shown in the FR '536 drawings or described in that reference, it would have been readily apparent to one of ordinary skill in the art that a check valve at the outlet of the pouring valves would be needed so that the upward movement of the piston in the valves

could suck the candy masses into the cylinders of the pouring valves. Thus, the applied references would have fairly suggested, to one of ordinary skill in the art, use of a check valve in the FR '536 pouring valves.

Appellants argue that even if it would have been obvious to one of ordinary skill in the art to include a check valve in the apparatus resulting from the combination of FR '536 and Reetz, it would not have been obvious to such a person to place the check valve between the imbibing openings and the twisted blade (brief, page 14). The examiner has set forth a very good reason why one of ordinary skill in the art would have placed the check valve before the twisted blade, i.e., so that flow through the check valve would not damage the marbleizing produced by the twisted blade (answer, page 8). Appellants argue that Warren places his check valve in the nozzle (brief, page 14), but do not explain why one of ordinary skill in the art, when considering the applied references in combination, would not have placed the check valve upstream of the twisted blade to obtain the benefit of doing so set forth by the examiner. Consequently, appellants'

argument is not well taken.

For the above reasons we conclude, based upon the preponderance of the evidence, that the invention recited in claim 4 would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

Rejection of claims 5, 7 and 10

Claim 5 requires that the cross section of at least one imbining opening is different from that of the other openings. Claim 7 requires means for stopping up at least one of the imbining openings, and claim 10 recites that the stopping-up means is a bolt.

For a disclosure of the above elements required by claims 5, 7 and 10, the examiner relies upon Hahn. This reference discloses a method and apparatus for extrusion of multiple layer sheeting, wherein conduits through which resin flows to form the layers can be partially or completely blocked by screws (col. 5, lines 14-20; col. 6, lines 38-45; figures 4-6). The examiner argues that "[i]t would have been obvious for an artisan at the time of the invention, to provide the imbining openings of the piston/cylinder material feeding

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means of the primary prior art combination (France 2167536 taken together with Reetz) with openings of different cross sections and flow stopping means, in

view of Hahn et al, since such would greatly increase the flexibility of the apparatus of the primary prior art combination" (answer, pages 5-6).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84.

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The examiner has not provided such an explanation. The examiner has merely stated that there would be a benefit of using Hahn's screw for varying the cross section of the FR '536 imbibing openings or stopping the flow through them, without explaining why the teachings in the references would have led one of ordinary skill in the art to do so. Consequently, we reverse the rejection of claims 5, 7 and 10.

DECISION

The rejection of claims 4 and 9 under 35 U.S.C. § 103 over FR '536 in view of Reetz and Warren is affirmed. The rejection of claims 5, 7 and 10 under 35 U.S.C. § 103 over FR '536 in view of Reetz and Hahn is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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EDWARD C. KIMLIN)	
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Administrative Patent Judge)	APPEALS AND
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